

## **REMARKS**

Applicants have amended claim 12 and added new claims 42-44. Claims 1-44 are pending.

In the Office Action, the Examiner indicated that she has withdrawn the prior election of species requirement after considering Applicants' response. Applicants greatly appreciate the Examiner's careful consideration of Applicants' Response filed on May 15, 2003, and her decision to withdraw the previous election requirement.

Before discussing claim rejections set forth in the Office Action, Applicants respectfully note that the Office Action appears to include an ambiguity regarding the status of claim 36. Although the Office Action Summary includes claim 36 in the general listing of rejected claims, the remainder of Office Action does not list claim 36 in any of the specific claim rejections appearing in the Office Action. Accordingly, Applicants are uncertain about the status of claim 36 and do not know whether the Examiner might have intended to indicate that claim 36 is allowable. If any subsequent Office Action includes a specific rejection of claim 36, Applicants respectfully request that such an Office Action be designated as being "non-final" in order to provide Applicants with a full and fair opportunity to respond to any such claim rejection.

Claims 37, 40, and 41 were rejected under 35 U.S.C. §102(b) as being anticipated by International Application No. WO 90/15215 to Jeong ("Jeong").

Applicants respectfully submit that the Section 102(b) rejection based on Jeong should be withdrawn because Jeong does not disclose all of the features recited in independent claim 37. In particular, Jeong does not disclose, *inter alia*, a device "configured so that [an] end portion of [a] cover opening limiter moves into [a] base

recess when [a] cover is moved from [an] open position to [a] closed position,” as recited in claim 37.

The Office Action at page 2 appears to equate reference numerals 90 and 39 of Jeong with the recited cover opening limiter and at least one base recess, respectively. In addition, the Office Action at page 3 cites Fig. 7B of Jeong for the asserted disclosure of a device configured so that an end portion of a cover opening limiter moves into a base recess. Contrary to these assertions, however, neither Fig. 7B nor any other portion of Jeong discloses a device “configured so that [an] end portion of [a] cover opening limiter moves into [a] base recess when [a] cover is moved from [an] open position to [a] closed position,” as recited in claim 37.

Reference numeral 90 of Jeong refers to a C-shaped plate spring that ensures resilient opening and closing of a box. Jeong at page 3, lines 11 and 22-25. Jeong at page 4, lines 10-13 indicates that “two ends of the spring 90 [are] engaged with the holes 39 and 29 provided in [a] body 30 and [a] cover [20] respectively.” Contrary to the apparent assertions in the Office Action, Fig. 7B of Jeong does not disclose a configuration having an end portion of the C-shaped plate spring 90 that moves into the hole 39 when a cover is moved from an open position to a closed position. Indeed, Fig. 7B appears to show the end of the spring 90 attached to body 30 without being movable into the hole 39 at all, especially when the open-box view of Fig. 7B is compared to the closed-box view of Fig. 7A, which shows the end of spring 90 positioned in hole 39 in a manner appearing to be the same as that shown in Fig. 7B. Furthermore, nothing else in Jeong discloses any “configur[ation] so that [an] end

portion of [a] cover opening limiter moves into [a] base recess when [a] cover is moved from [an] open position to [a] closed position,” as recited in claim 37.

For at least these reasons, independent claim 37 should be allowable over Jeong. Claims 40 and 41 depend from claim 37 and, thus, should be allowable for at least the same reasons claim 37 is allowable.

In the Office Action, claims 38 and 39 were rejected under 35 U.S.C. §103(a) based on Jeong in view of U.S. Patent No. 4,807,773 to Tsai (“Tsai”).

Applicants respectfully submit that the rejection of claims 38 and 39 should be withdrawn because claims 38 and 39 depend from claim 37 and, therefore, are allowable for at least the same reasons claim 37 is allowable.

Claims 1-4 were rejected under 35 U.S.C. § 103(a) based on U.S. Patent No. 6,283,298 to Seidler (“Seidler”) in view of Tsai. In the Office Action at page 4, the Examiner acknowledges that “Seidler fails to show . . . first and second magnets associated with the base and cover and the angular extent being less than 180 degrees and greater than or equal to 100 degrees.” Despite these acknowledged deficiencies, the Office Action at page 5 alleges that “[i]t would have been an obvious matter of design choice to construct one first magnet at the base and the second magnet at the cover,” and that “[i]t would have been obvious . . . to construct the angular extent . . . since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.”

Applicants respectfully submit that the Section 103(a) rejection of claims 1-4 should be withdrawn because the Office Action does not set forth a *prima facie* case of

obviousness. To establish *prima facie* obviousness under 35 U.S.C. § 103(a), the Examiner must show first that the prior art references teach or suggest all of the claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Second, the Examiner must show that there is some suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references in a manner resulting in the claimed invention. *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998). Third, the Examiner must show that there is a reasonable expectation of success to modify or combine the references. *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988). Moreover, “[b]oth the suggestion and the reasonable expectation of success must be found in the prior art reference, not in the Applicant’s disclosure.” *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991).

In this case, *prima facie* obviousness has not been established because (1) neither Seidler, nor Tsai, nor any combination thereof, teaches or suggests all of the features recited in claims 1-4; and (2) even hypothetically if some combination of those references could yield all of the claimed features, the Office Action does not provide a proper motivation, suggestion, or teaching to combine or modify the references in a manner resulting in Applicants’ claimed invention.

Regardless of whether Seidler could be combined with Tsai as proposed in the Office Action, such a hypothetical combination does not provide any disclosure or suggestion of a device including, among other features “at least one first magnet associated with [a] base and at least one second magnet associated with [a] cover, the first and second magnets coupling the base and the cover together so as to permit

movement of the cover with respect to the base, in a generally hinge-like manner, between a closed position in which the cover covers [an] opening of [a] compartment and an open position in which access to the compartment is permitted,” as recited in claim 1. Furthermore, the hypothetical combination of Seidler and Tsai does not disclose or suggest a device “configured to limit an extent of generally hinge-like movement of [a] cover so that when the cover is moved from the closed position to the open position, the cover moves with respect to [a] base up to a maximum angular extent of less than 180 degrees and greater than or equal to about 100 degrees,” as recited in claim 1.

Nothing provides any motivation, suggestion, or teaching for the purported modification of Seidler to include the first and second magnets recited in claim 1. Although Seidler refers to a closure mechanism that may be a “magnetic assembly” (col. 3, lines 63-67), Seidler does not provide any details of how such a “magnetic assembly” would be arranged. For example, nothing provides any indication of whether the magnetic assembly would have more than one magnet or only a single magnet, and there is no disclosure of how any magnet might be arranged. Thus, neither Seidler nor any other source cited in the claim rejection provides disclosure or suggestion of “at least one first magnet associated with [a] base and at least one second magnet associated with [a] cover,” as recited in claim 1. Moreover, nothing cited in the claim rejection provides any motivation, teaching, or suggestion for modifying Seidler to include “first and second magnets coupling [a] base and [a] cover together so as to permit movement of the cover with respect to the base, in a generally hinge-like manner, between a closed position in which the cover covers [an] opening of [a]

compartment and an open position in which access to the compartment is permitted,” as recited in claim 1.

Applicants also respectfully submit that rejection of claims 1-4 should be withdrawn because nothing supports the assertion in the Office Action at page 5 regarding the purported “obvious matter of design choice.” This conclusory assertion lacks any factual support in the record and reflects an apparent attempt to reject the claims in a hindsight fashion based on Applicants’ disclosure. If the Examiner insists on maintaining the claim rejection based on this unsupported “design choice” reasoning, Applicants respectfully request that the Examiner supply a personal affidavit explaining the basis for the “design choice” assertion, so that Applicants will be able to respond in kind. (See 37 C.F.R. § 1.104(d)(2)).

In addition to the fact that there is no disclosure or suggestion of the features recited in claim 1 relating to first and second magnets, the purported combination of Seidler and Tsai also does not disclose or suggest a device “configured to limit an extent of generally hinge-like movement of [a] cover so that when the cover is moved from [a] closed position to [an] open position, the cover moves with respect to [a] base up to a maximum angular extent of less than 180 degrees and greater than or equal to about 100 degrees,” as recited in claim 1. Contrary to the Examiner’s apparent assertion, neither one of the cited references discloses the “general conditions” of the claim. For example, the cited references do not appear to mention the extent of hinge-like movement of a cover or have any disclosure or suggestion of any maximum angular extent. Here again, rather than setting forth a *prima facie* case of obviousness, the

Office Action appears to reject the claims in a hindsight fashion based on Applicants' disclosure.

For at least these reasons, Applicants respectfully submit that the Section 103(a) rejection of independent claim 1 and dependent claims 2-4 should be withdrawn.

In the Office Action, claims 5-8 were rejected under 35 U.S.C. § 103(a) based on Seidler in view of Tsai and Jeong. Applicants respectfully submit that the rejection of claims 5-8 should be withdrawn because claims 5-8 depend from claim 1 and, therefore, are allowable for at least the same reasons claim 1 is allowable.

Claims 1 and 9 were rejected under 35 U.S.C. §103(a) based on U.S. Patent No. 5,135,012 to Kamen et al. ("Kamen et al."). The Office Action at page 7 acknowledges that "Kamen et al fails to show the angular extent of less than 180 degrees and greater than or equal to about 100 degrees," but, in a legally improper manner similar to the above-mentioned rejection of claim 1 based on Seidler and Tsai, the Office Action alleges that "[i]t would have been obvious . . . to construct the angular extent . . . since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art."

Applicants respectfully submit that the Section 103(a) rejection of claims 1 and 9 should be withdrawn because the Office Action does not set forth a *prima facie* case of obviousness. Kamen et al. does not provide any disclosure or suggestion of a device "configured to limit an extent of generally hinge-like movement of [a] cover so that when the cover is moved from [a] closed position to [an] open position, the cover moves with respect to [a] base up to a maximum angular extent of less than 180 degrees and

greater than or equal to about 100 degrees,” as recited in claim 1. Despite the Examiner’s apparent assertion, Kamen et al. does not disclose the “general conditions” of the claim. For example, the cited reference does not appear to mention the extent of hinge-like movement of a cover or have any disclosure or suggestion of any maximum angular extent. Once again, rather than setting forth a *prima facie* case of obviousness, the Office Action appears to reject the claims in a hindsight fashion based on Applicants’ disclosure. Consequently, the Section 103(a) rejection of independent claim 1 and dependent claim 9 should be withdrawn.

In the Office Action, claims 10, 11, 25-28, and 33-35 were rejected under 35 U.S.C. §103(a) based on Kamen et al. in view of Tsai. The Office Action at pages 7-8 acknowledges that Kamen et al. does not disclose “first and second plate-shaped members each having magnets coupling to each other by stacking on one another . . . .” Further, the Office Action at page 8 asserts that [i]t would have been obvious . . . to employ the particular base as taught by Tsai into the device of Kamen et al. . . .”

Applicants respectfully submit that the Section 103(a) rejection of claims 10, 11, 25-28, and 33-35 should be withdrawn because the Office Action does not set forth a *prima facie* case of obviousness. For example, the purported combination of Kamen et al. and Tsai does not disclose or suggest a “base compris[ing] a first member and a second member, wherein the first and second members comprise magnets coupling the first and second members together with one of the members being stacked on the other member,” as recited in independent claim 25. In addition, the cited references do not disclose or suggest the subject matter of claim 10, which depends from claim 1.



Nothing provides any motivation or suggestion for modifying the Kamen et al. reference to include the vertically assembled compact of Tsai. Further, even if Tsai could be combined with Kamen et al. in the hypothetical manner proposed in the Office Action, the subject matter of claims 10 and 25 would not result, because neither one of those references discloses or suggests a base comprising first and second members including magnets coupling the members together with one of the members stacked on the other member, as recited in claims 10 and 25. Although Kamen et al. shows a "base 112" impregnated with magnetic particles 146 and a lid 114 impregnated with magnetic particles 148, Kamen et al. does not disclose or suggest the recited base comprising first and second members including magnets coupling the members together with one of the members stacked on the other member. Tsai also does not provide any disclosure or suggestion of such subject matter. Indeed, the compact of Tsai has body portions assembled together by means of a pivot 13 tightly and elastically inserted into a pivot hole 14, without having any magnets coupling base members together. Col. 2, lines 2-14. Accordingly, even if Tsai could be combined with Kamen et al., the subject matter recited in claims 10 and 25 would not result.

Applicants also respectfully submit that the Section 103(a) rejection of claims 10, 11, 25-28, and 33-35 should be withdrawn because the cited references do not provide any disclosure or suggestion of a device "configured to limit an extent of generally hinge-like movement of [a] cover so that when the cover is moved from [a] closed position to [an] open position, the cover moves with respect to [a] base up to a maximum angular extent of less than 180 degrees and greater than or equal to about 100 degrees," as recited in claim 25 and in claim 10 (i.e., by virtue of its dependency

from claim 1). As noted above, Kamen et al. does not appear to mention the extent of hinge-like movement of a cover or have any disclosure or suggestion of any maximum angular extent. Moreover, Tsai does not remedy the deficiencies of Kamen et al. Accordingly, the Section 103(a) rejection of independent claim 25 and dependent claim 10 should be withdrawn.

For at least these reasons, claims 10 and 25 should be allowable over the cited references. Since claim 11 and claims 26-28 and 33-35 depend from claims 10 and 25, respectively, those dependent claims should also be allowable for at least the same reasons as the claims from which they depend.

In the Office Action claims 29-32 were rejected under 35 U.S.C. §103(a) based on Kamen et al., Tsai, and Jeong. Applicants respectfully submit that the rejection of claims 29-32 should be withdrawn because claims 29-32 depend from claim 25 and, therefore, are allowable for at least the same reasons claim 25 is allowable.

Claims 12-21 were rejected under 35 U.S.C. §103(a) based on Kamen et al. in view of Jeong. Applicants respectfully submit that the Section 103(a) rejection of claims 12-21 should be withdrawn because there would have been no motivation or suggestion for one of ordinary skill in the art to combine features of Kamen et al. and Jeong without the hindsight benefit of Applicants' disclosure. Kamen et al. and Jeong are directed to very different subject matter. For example, Kamen et al. relates to a compact and discusses how "[t]he use of a hinge is disadvantageous because it sets a practical limit on how thin the compact case can be . . . ." Col. 1, lines 21-31. In contrast, Jeong relates to a relatively thick article, such as a jewelry box, which is integrally-formed with a hinge. See, for example, the title and drawings of the Jeong reference. Accordingly,

one of ordinary skill in the art would not have had any legally sufficient motivation or suggestion for combining the Jeong and Kamen et al. disclosures.

Applicants also respectfully submit that the rejection of claims 12-21 should be withdrawn because neither Kamen et al., nor Jeong, nor any combination thereof discloses or suggests a device including, among other features, “first and second magnets coupl[ing a] base and [a] cover together during [a] generally hinge-like movement of the cover between [an] open position and [a] closed position,” as recited in amended claim 12. For example, Kamen et al. does not disclose or suggest the magnetic particles 146 and 148 providing coupling during any hinge-like movement of the lid 114. Further, Jeong does not appear to disclose magnets.

For at least these reasons, independent claim 12 and dependent claims 13-21 should be allowable.

In the Office Action claims 22-24 were rejected under 35 U.S.C. §103(a) based on Kamen et al., Jeong, and Tsai. Applicants respectfully submit that the rejection of claims 22-24 should be withdrawn because claims 22-24 depend from allowable claim 12 and, therefore, are allowable for at least the same reasons claim 12 is allowable.

As explained above, all of the claim rejections should no longer be applicable and all of the rejected claims should now be allowed. New claims 42-44 depend from one of claims 1 and 12 and, thus should be allowed for at least the same reasons as the claims from which they depend.

In view of at least the reasons explained above, all of the pending claims should be allowable. If the Examiner believes a telephone conversation or interview might advance prosecution, the Examiner is invited to call Applicants' undersigned representative (571-203-2774).

Applicants respectfully request reconsideration of this application, withdrawal of all of the claim rejections, and timely allowance of the pending claims.

The Office Action contains a number of statements relating to the claims and the cited references. Applicants decline to subscribe to any statement in the Office Action, regardless of whether it might be specifically mentioned above. In particular, Applicants decline to subscribe to any characterization of the claims or the cited references.


Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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By: \_\_\_\_\_

  
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